

REM 5/30/03

05/30/2003 16:36 FAX 415 393 9887

SQUIRE SANDERS & DEMPSEY

0010

PATENT
Attorney Docket No.: 50623.00041

REMARKS

- Claims 1, 2, 5, 8-18, 20-22, and 24-35 are pending.
- Claims 1, 2, 5, 8-18, 21, 22, and 24-35 are rejected.

Claims 1 and 35 have been amended to clarify that the temperature is maintained during the coating or applying step. Also, the coating material is now required to contain a fluid. All of these amendments are fully supported by the application, as filed, and do not present new matter.

Applicants wish to point out that the claims as originally filed were in part directed to medical devices. During prosecution the claims were narrowed in an attempt to overcome prior art by limiting the medical device to a stent. Since that was unsuccessful, in the previous response the medical device element was reintroduced into the claims. In view of that, it was improper for the Examiner to refuse entry of the amendment after final because of applicants' broadening of the scope of the claims necessitated a new search.

35 U.S.C. § 102 Claim Rejections

The examiner has rejected claims 1, 2, and 35 under 35 U.S.C. § 102(e) as being anticipated by Tseng et al., U.S. Patent No. 6,364,903, the 903-patent.

This rejection does not name Claim 4. Applicants have amended claims 1 and 35 to contain all the limitations of Claim 4, thereby making this rejection moot. Since the 903-patent does not teach each and every element of claims 1, 2, and 35, it does not anticipate these claims. Please remove this rejection under 35 U.S.C. § 102(e).

Claims 1, 2, 4, 24, and 35 are rejected under 35 U.S.C. §103(a) as being unpatentable over Berg, U.S. Patent No. 5,464,650, the 650-patent, in view of Pursley, U.S. Patent No. 6,030,371, the 371-patent.

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Upon discussing the Pursley reference the Examiner, it became clear that the Examiner considers Pursley as teaching a number of embodiments, one of which arguably teaches applying a fluid-containing coating material to a heated medical device. One the other hand, Pursley teaches a number of embodiments in which heated medical devices are treated with a solid polymer coating material. Pursley also teaches a number of embodiments with fluid-containing coating materials. Pursley must be viewed as a whole. The fact that it teaches some embodiments that contain-fluid and some embodiments that use a heated substrate, and vaguely includes a sentence that MIGHT mean that a fluid-containing coating material can be used with a heated substrate does not rise to the level of being anticipatory. Pursley, if it teaches using a fluid-containing coating material at all, does not clearly teach using such a material. And even if the sentence does teach using such a material, the Pursley-disclosure does not enable the invention. Note that every time Pursley enables using a heated substrate with a polymer material, the polymer material is a solid polymer.

The 371-patent nowhere links heating a metal substrate with spraying a solvent-based polymer component. In fact, the disclosure goes to great lengths to show that when a metal substrate is heated, the polymer component is to be provided as a solid polymer.

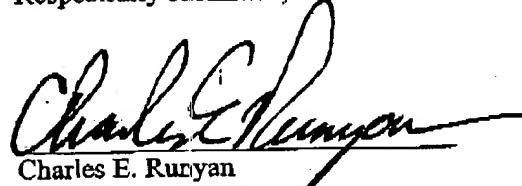
One of ordinary skill in the art would not learn to use or HOW to use a fluid-based polymer component with a heated substrate from the 371-patent. Therefore, the cited art combination does not in fact teach or suggest each and every element of claim 1, 2, 4, 24, and 35. Since the 371-patent does not teach driving off a solvent using a heated substrate, it would not have been obvious to one of ordinary skill in the art to apply the teaching of the 371-patent with the method of the 650-patent.

Please remove this rejection under 35 U.S.C. § 103(a).

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Since all claims are in a condition for allowance, please issue a Notice of Allowability so stating. If I can be of any help, please contact me.

Respectfully submitted,



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